

REMARKS

Applicants have amended claims 1 and 6; canceled claims 4, 9-25, and 29-31; and added new claims 32-38. Claims 1, 3, 6-8, 26-28, and 32-38, of which claims 1 and 32 are independent in form, are presented for examination. Claim 1, as amended, corresponds to previously presented claim 4 (now canceled), and claim 32 corresponds to previously presented claim 6.

Claim 1 has been rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,379,380 (Satz). Independent claims 1 and 32 recite the features of previously presented claims 4 and 6, which were not rejected as anticipated by Satz. Accordingly, this rejection should be withdrawn.

Claims 1, 3, 8, and 26-28 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,443,498 (Fontaine) in view of U.S. Patent No. 5,628,787 (Mayer) and further in view of U.S. Patent No. 5,226,909 (Evans). Independent claims 1 and 32 recite the features of previously presented claims 4 and 6, which were not rejected as being unpatentable over Fontaine in view of Mayer and further in view of Evans. Accordingly, this rejection should be withdrawn.

Claims 4, 6, 7, 13-15, 20-22, 25, and 29-31 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Fontaine in view of Mayer and Evans, and further in view of "Rhenium and Molybdenum/Tungsten Based Alloys: An Overview of Database (Bryskin). The Examiner has acknowledged that Fontaine, Mayer and Evans fail to disclose the composition of an alloy including tungsten and rhenium as claimed, and has relied to Bryskin for the missing feature. As the sole motivation for combining these references, the Examiner has stated that Bryskin suggests that tungsten-rhenium alloys have many advantages when used to form medical devices, and that these compositions are known to have suitable mechanical properties for forming medical devices.

Applicants have reviewed Bryskin and cannot find where this reference discloses, or even mentions, that the claimed alloy compositions can be applied to stents or any medical devices. Indeed, the Examiner has not indicated with any specificity where Bryskin provides the support for combining the references. As a result, since the Examiner has acknowledged that Fontaine,

Mayer, and Evan fail to disclose the claimed alloy compositions for stent or medical device application, none of the references, alone or in combination, discloses or suggests the medical implants recited in the claims.

Applicants note that an obviousness rejection cannot be predicated on a standard that it would have been obvious to make a medical implant by trying a particular alloy unless there is some specific guidance that would lead a person of ordinary skill in the art to a reasonable expectation of success with regard to that alloy. As instructed by the Federal Circuit in In re O'Farrell 853 F.2d 894, 903-4 (Fed. Cir. 1988):

The admonition that "obvious to try" is not the standard under § 103 has been directed mainly at two kinds of error. In some cases, what would have been "obvious to try" would have been to vary all parameters or try each of numerous possible choices until one possibly arrived at a successful result, where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful. [citations omitted]. In others, what was "obvious to try" was to explore a new technology or general approach that seemed to be a promising field of experimentation, where the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it. [citations omitted]

* * *

Obviousness does not require absolute predictability of success.... For obviousness under § 103, all that is required is a reasonable expectation of success. [citations omitted]

There is no guidance in Bryskin's compilation of tungsten-rhenium alloys as to which of its alloys, if any, would provide advantages for constructing a medical implant. Nor do the cited references provide any general expectation that the claimed tungsten-rhenium alloy would be advantageous, or even successful, when applied to a medical implant. Applicants submit that the rejection does not consider Applicants' invention as a whole and instead uses Applicants' specification as a template for selecting elements from the references to construct an obviousness rejection. This rejection is clearly improper, and therefore, Applicants request that the rejection be reconsidered and withdrawn.

For at least the reasons discussed above, Applicants believe the claims are in condition for allowance, which action is requested.


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Respectfully submitted,

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